



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,023	01/15/2002	David D. Chase	39697/25488	5503
29493	7590	12/30/2005		
HUSCH & EPPENBERGER, LLC 190 CARONDELET PLAZA SUITE 600 ST. LOUIS, MO 63105-3441				
			EXAMINER	
			FOREMAN, JONATHAN M	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,023

Applicant(s)

CHASE ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50, 52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 15-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13, 40-45, 48, 52 and 53 is/are rejected.
- 7) ☒ Claim(s) 14, 46, 47, 49 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on 6/16/05. These drawings are accepted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 52 depends from a cancelled claim and therefore is indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 9, 10, 40 – 43, 48, 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,984,886 to Miller.

In regards to claims 9, 10, 40 – 43, 48, 52 and 53, Miller discloses a joint support belt having a front, a back and side panels sized to fit about the lower trunk of a user (Col. 5, lines 42 – 49), at positions substantially 90° and 270° from the human user's navel (Figure 2; Col. 6, lines 7 – 8), first and second sets of protrusions disposed at the side panels on the anterior surface of the belt body to press against the sides of the lower trunk of the user (Col. 6, lines 5 – 10; 15 – 22). No protrusions are disposed on the back of the human body. The positioning of a side panel will be a result of the body shape and size of the user (Col. 6, lines 11 – 14). The belt includes a placement structure

Art Unit: 3736

comprising back adjustment mechanism (Col. 5, lines 50 – 61) capable of facilitating the placement of the support body at least one inch below the navel of a user.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,984,886 to Miller.

In regards to claims 11, 13, 44 and 45, Miller discloses protrusions (31) in a set and discloses multiple sizes of belts (Col. 6, lines 11 – 14), but fails to disclose the protrusions having a height from approximately one-eighth inch to one inch and being between approximately four millimeters and seventy millimeters measured center to center, from each other. However, a change in the size of a prior art device is a design consideration within the skill of the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Here, modifying the size and spacing of the protrusions as disclosed by Miller be approximately one-eighth inch to one inch in height and between approximately four millimeters and seventy millimeters measured center to center would have been obvious to one having ordinary skill in the art at the time the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,984,886 to Miller as applied to claim 11, and further in view of U.S. Patent No. 5,769,803 to Brossard.

In regards to claim 12, Miller discloses first and second sets of protrusions (31) along the body of the support belt, but fails to disclose additional protrusions applying less pressure to the lower trunk of the user between the first and second sets of protrusions. However, Brossard discloses a set of protrusions (60; Figure 19) applying light pressure (Col. 10, lines 27 – 30) positioned on an area of a support belt lying between the positions of the protrusions as disclosed by Miller. It would have been obvious to one having ordinary skill in the art to modify the support belt as disclosed by Miller to include a set of protrusions as taught by Brossard in order to increase the reflex response of the muscle group (Abstract) located in the lumbar region.

Response to Arguments

Applicant's arguments filed 10/6/05 have been fully considered but they are not persuasive. Applicant has asserted that the protrusions as disclosed by Miller are not at positions substantially 90° and 270° from the human user's navel. However the Examiner disagrees. "Substantially" is a relative term. Nevertheless, Figure 2 shows the protrusions being positioned over the iliac crests of a wearer which are located at positions substantially 90° and 270° from the human user's navel. Additionally, Applicant asserts that Miller fails to disclose the protrusions stimulating the wearer's muscles to reduce any tendency of the muscles of the back of the wearer to overcompensate in response to sudden or unexpected loading events. However, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation

Art Unit: 3736

does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function. *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). In addition, where there is reason to believe that such functional limitation may be an inherent characteristic of the prior art reference, Applicant is required to prove that the subject matter shown in the prior art reference does not possess the characteristic relied upon. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); *In re Ludtke*, 441 F.2d 664, 169 USPQ 566 (CCPA 1971). Additionally, Applicant asserts that Miller fails to disclose a back adjustment mechanism capable of facilitating placement of the support body at least one inch below the navel of a user. However, the Examiner disagrees. The support belt as disclosed by Miller is fully capable of being worn one inch below the navel. The back adjustment mechanism disclosed by Miller is fully capable of positioning the belt one inch below the navel of the wearer. The positioning of the support belt is merely an intended use recitation providing no structural limitation upon the claimed apparatus.

Allowable Subject Matter

8. Claims 14, 46, 47, 49 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

Art Unit: 3736

mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JMLF



ALI IMAM
PRIMARY EXAMINER
for Max